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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,223	09/17/2003	Kevin L. Parsons	8342-90321	6280

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EXAMINER

BUI, LUAN KIM

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,223

Applicant(s)

PARSONS, KEVIN L.

Examiner

Luan K Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. Applicant is required to update the current status of the parent applications as indicated on page 1 of the instant patent application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-8 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester (5,794,631) in view of Stearns (5,469,965) or Saye (5,575,384). Sylvester discloses a packaging (20) for a product comprising a holder (31) holding products such as video cassettes, audio cassettes or compact discs which is considered equivalent to a tray and a card for covering and containing the tray. The card including a first panel (27) folded over a second panel (26) to form an inner compartment (30) for containing the tray and a third panel (22, 42, 43) that serves as a cover. The cover having a first default position when it covers the inner compartment and a second open position when the cover is raised and the inner compartment is exposed. Sylvester further discloses the cover comprising a fourth panel (43) folded over the third panel and the use of fastening means (40) is optional (column 7, line 14). Since the cover formed by the third and fourth panels and due to the weight of the cover and also the use of the fastening means is optional, the cover disposed to remain in the first closed position in contact relation to the inner compartment without locking means. To the extent that Sylvester fails to show a tray for carrying the product, Stearns discloses a packaging (10) for a product comprising

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a tray (52-54) for carrying a product and a card for covering and containing the tray including a first panel (18) having a window (20) folded over a second panel (12) having a second window (55) to form an inner compartment therebetween for containing the tray, and a third panel (26, 30) that serves as a cover and folded over the inner compartment. Saye discloses a packaging for a product comprising a tray (62, 66-70) having a flocked surface with a cavity for carrying a product and a card for covering and containing the tray including a first panel (34) folded over a second panel (84) to form an inner compartment therebetween for containing the tray, and a third panel (25, 26) that serves as a cover. It would have been obvious to one having ordinary skill in the art in view of Stearns or Saye to modify the packaging of Sylvester so it comprises a tray for carrying the product for better protecting the product during shipping and/or handling.

As to claim 6, Sylvester fails to show the cover comprises a cut-out portion. Stearns shows the cover comprises a cut-out (57). It would have been obvious to one having ordinary skill in the art in view of Stearns to modify the cover of Sylvester as modified so the cover includes a cut-out for accommodating an article such as a photograph for better retaining the photograph. As to claim 7, Sylvester fails to show the inner compartment being provided with a window. It would have been obvious to one having ordinary skill in the art in view of Stearns to modify the packaging so the inner compartment includes a window to provide visual access to the contents within the inner compartment. As to claim 13, Sylvester discloses a flap (37, 38) connected to the first panel. The tray of Sylvester as modified is capable to carry a flashlight or a medallion.

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4. Claims 3, 9, 12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1 and 7 above, and further in view of Heuer et al. (4,739,353; hereinafter Heuer'353) or Appelbaum et al. (5,409,105; hereinafter Appelbaum'105). Sylvester further fails to show the window being a clear lid placed over a raised portion of the tray. Heuer'353 shows a packaging comprising a tray (4) having a raised portion with at least one cavity (11) for carrying a product and a package (16) having a window (17) with a clear lid (4b) placed over the raised portion of the tray. Appelbaum'105 teaches a packaging comprising a tray (34) having a raised portion (32) for carrying a product and a package (20) having a window (24) with a clear lid placed over the raised portion of the tray. It would have been obvious to one having ordinary skill in the art in view of Heuer'353 or Appelbaum'105 to modify the packaging of Stearns so the tray includes a raised portion and the window includes a clear lid placed over the raised portion for better display the product and further protecting the product.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Claims 1-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,659,271. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structural limitations in the claims of the instant patent application are fully disclosed by the patents.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is (703) 305-5861. If in receiving this Office Action, it is apparent to Applicant that certain documents are missing from the record for example copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to TC 3700 Customer Service at (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application should be directed to the Customer Service whose telephone number is (703) 872-9301. Facsimile correspondence for this application should be sent to (703) 872-9306 for Formal papers and After Final communications.

lkb
May 14, 2004


Luan K. Bui
Primary Examiner